

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Examiner : Michael S. Chambers
Art Unit : 3711
Appellant : David Morrow
Serial No. : 10/642,879
Filing Date : August 18, 2003
For : LACROSSE HANDLE
Attorney Docket : 086624.130516

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

This is an appeal from a final rejection of claims 54-56 by Examiner Chambers.

I. Real Party in Interest

The real party in interest is Warrior Sports, Inc., of 32125 Hollingsworth Avenue,
Warren, Michigan 48092.

II. Related Appeals and Interferences

There are no related Appeals or Interferences.

III. Status of Claims

Claims 41, 42, 44-47, 50-52 and 54-56 are pending and finally rejected.
Appellant appeals with respect to claims 54-56.

Appellant does not appeal with respect to the rejections of claims 41 and 44 under

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35 U.S.C. 112, or the rejections of claims 41, 42, 44-47, 50-52 under 35 U.S.C. 103. Appellant will address the rejections of these claims following the outcome of this appeal. In addition, Appellant does not appeal with respect to the provisional double patenting rejection of claims 41 and 54. If any claims of this application are allowed and a Terminal Disclaimer is necessary, Appellant will file a Terminal Disclaimer.

IV. Status of Amendments

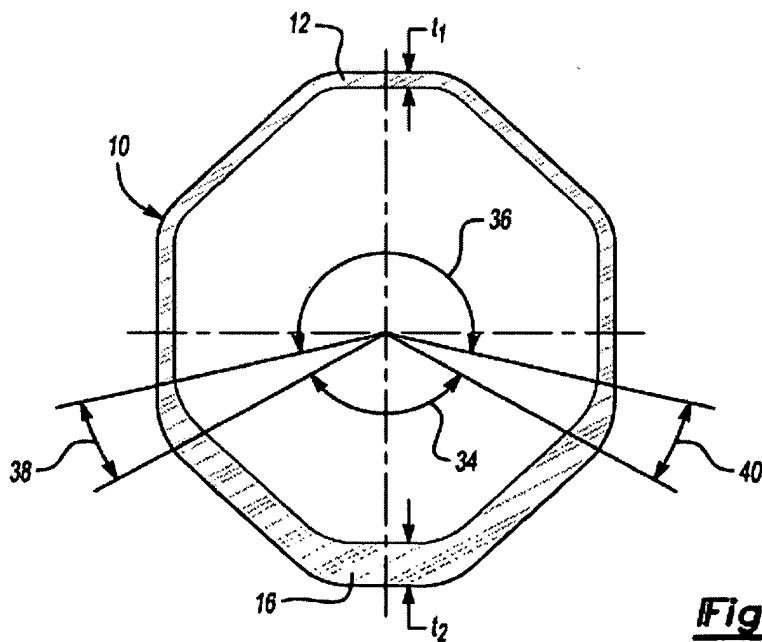
No amendment has been filed subsequent to the final rejection.

V. Summary of Claimed Subject Matter

The present invention is directed to equipment for playing the game of lacrosse, and more particularly to a lacrosse handle for attachment to a lacrosse head. The handle includes a non-uniform wall thickness, which provides an asymmetric weight distribution that enables feedback to the user of the lacrosse stick as to the orientation of the stick, and thus the lacrosse head, in the user's hands. [Page 3, paragraph 0007].

As defined in independent claim 54, the present invention is directed to a lacrosse stick including a hollow tube having a longitudinal length extending along a longitudinal axis between a first end and a second end. [Page 3, paragraph 12.] The first end is adapted to connect to a lacrosse head. [Page 3, paragraph 12.] The hollow tube includes an interior surface and an exterior surface defining a wall thickness therebetween, and the exterior surface has an octagonal shape in cross section along a plane normal to the longitudinal axis, the octagonal

shape including eight sides and eight corners, wherein the hollow tube includes an outer perimeter that is substantially uniform from the first end to the second end, wherein the hollow tube defines a centerline extending in the plane through the longitudinal axis, the center line dividing the hollow tube into opposing first and second portions wherein the wall thickness of at least one of the sides and the corners in the first portion is greater than the wall thickness of at least one of the sides and the corners in the second portion, such that the difference in wall thickness provides the hollow tube with an asymmetrical weight distribution about the centerline that provides feedback to the user of the lacrosse stick as to the orientation of the hollow tube, and thus the lacrosse head, in the user's hands. [Page 4, paragraphs 24-27; Fig. 3]. A cross section showing one embodiment, and the features presented above, is in Fig. 3, below.



VI. Grounds of Rejection To Be Reviewed on Appeal

A. Claims 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,568,925 to Morrow (“Morrow”) in view of U.S. Patent 3,697,069 to Merola (“Merola”) and a Non-Patent Literature Document to HauteStick (“HauteStick”).

VII. Argument

A. Claim 54-56 Are Not Obvious In View of Morrow, Merola and HauteStick.

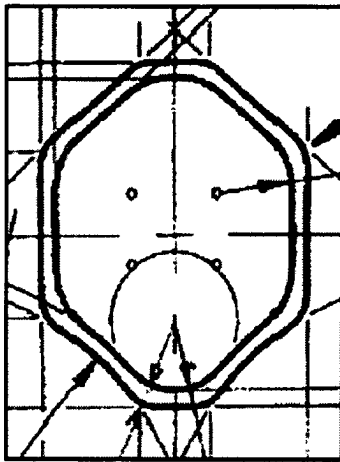
Claims 54-56 are rejected under 35 U.S.C. Section 103(a) as being unpatentable on the basis of Morrow in view of Merola and HauteStick.

1. The Cited References

Morrow discloses a scooped lacrosse head that is attached to a conventional hollow, octagonal lacrosse handle, which includes a *uniform wall thickness* about its entire cross section. Morrow, Col. 3, Lns. 46-49. Merola discloses a baseball bat with a circular cross section having an eccentric wall thickness. Merola states that “the wall thickness of the tube [i.e. bat] is eccentric to present a stronger ball striking area when the bat is properly oriented.” Merola, Abstract. The exterior perimeter of the Merola bat *tapers* from a generally wide barrel portion to a generally narrow handle portion. HauteStick (shown in cross-section below) discloses an octagonal lacrosse handle wherein all eight sides have the same wall thickness, and wherein all eight of the corners have a wall thickness that is *greater than* the wall thickness of

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the sides. According to HauteStick, the increased thickness at the corners creates extra strength at the corners that makes the corners stronger and stiffer, where strength is needed the most. HauteStick, page 3.



2. Summary of the Section 103 Rejection

The rejection of claim 54 is not specifically addressed in the Office Action. Instead, the Office Action states: "As to claim 54, See claim 41 rejection." March 13, 2009 Office Action, page 4. With respect to claim 41, the Office Action generally provides that: (a) Morrow discloses a hollow shaft; (b) HauteStick discloses it is old to desire to strengthen a portion of a shaft to increase its strength for checking the user's opponent; and (c) Merola discloses an eccentric shaft to strengthen the [ball striking area]. March 13, 2009 Office Action, page 3. The Office Action asserts that "it would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the eccentric cross sectional shape of Merola with Morrow in order to increase strength of the shaft for checking during play." March 13, 2009 Office Action, page 3.

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The rejection of claim 55 states (in reference to the rejection of claim 50) that "The specification provides no unexpected or surprising results in using [this] limitation; therefore it is considered a design choice." March 13 2009 Office Action, page 4.

3. Discussion

Appellant submits that Morrow, Merola and HauteStick, either alone or in combination, do not disclose, teach or suggest every element of amended independent claim 54. In particular, the references fail to disclose, teach or suggest a lacrosse handle including an octagonal hollow tube having a wall thickness of at least one of the sides and the corners in a first portion on one side of a centerline that is greater than the wall thickness of at least one of the sides and one of the corners in a second portion on the opposite side of the centerline, such that the difference in wall thickness provides the hollow tube with an asymmetrical weight distribution about the centerline that provides feedback to the user of the lacrosse stick as to the orientation of the hollow tube, and thus the lacrosse head, in the user's hands. Morrow discloses a conventional lacrosse handle, which at the time would include a uniform wall thickness. HauteStick discloses, and expressly teaches, the strengthening of a lacrosse stick by increasing the wall thickness of *all* of the corners. HauteStick also expressly discloses decreasing the thickness of the walls to provide a lighter stick. HauteStick, page 3. Merola discloses an eccentric wall thickness, but only in connection with a non-polygonal baseball bat that necessarily has a *non-uniform* (i.e., tapered) exterior surface that is not designed or suitable to receive a lacrosse handle. See Merola, Fig. 2. Appellant submits that no combination of these reference would replicate the subject matter of claim 54.

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Appellant further submits that even if the references could somehow be combined or modified to include every element of the claimed invention, there is no reason why a person of skill in the art would do so. As the Supreme Court noted, “[i]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Intern. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). It is asserted that “it would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the eccentric cross sectional shape of Merola with Morrow in order to increase the strength of the shaft for checking during play.” Office Action, page 3. Appellant submits that even if this were true, it would not lead a person of skill in the art to arrive at the claimed invention, which includes a uniform exterior cross section *and* a non-uniform wall thickness. Merola fails to provide any reason why its round/circular eccentric baseball bat would be applicable to a lacrosse stick, let alone provide an asymmetric weight distribution that provides tactile feedback as to the orientation of a lacrosse handle and head. Merola teaches only that an eccentric wall thickness in a tapered baseball bat is beneficial in contacting a baseball. Indeed, Merola’s construction is so unlike the claimed subject matter in providing tactile feedback based on asymmetric weight distribution that Merola suggests providing an external marking on the bat in “assisting the batter to align the bat properly.” Col. 3, Lines 32-35. A person of skill in the art would have absolutely no reason to modify the *tapered* exterior perimeter of the Merola baseball bat into a *uniform* polygonal perimeter adapted to receive a lacrosse head in order substitute the eccentric wall thickness of Merola for the symmetric wall thickness of Morrow or HauteStick.

Appellant further submits that HauteStick actually expressly teaches away from the construction of the claimed invention. The Office Action asserts that a person of skill would combine the references for purposes of strengthening the stick; however, HauteStick teaches that *its* construction provides a handle with preferred stiffness characteristics for checking during play. Specifically, HauteStick teaches that: “By increasing the amount of low-weight material in the corners it creates eight tiny I-beams in every corner. This not only adds stiffness, but it adds strength.” HauteStick, page 3. If anything, HauteStick teaches away from the present invention by reciting the strength and stiffness advantages of its *symmetrically distributed* wall thickness. No person of skill in the art would read HauteStick as a suggestion to increase the wall thickness of a side and a corner on only one side of the centerline.

Because the prior art does not disclose, teach or suggest every element of amended independent claim 54 – or provide any reason for doing so – Appellant submits that the rejection under Section 103 with respect to Morrow, Merola and HauteStick should be reversed. The rejection of claims 55 and 56, which depend from claim 54, should be reversed for the reasons discussed above with regard to claim 54.

In addition, Appellant submits that claim 55, the rejection of this claim is predicated on a conclusion that is ungrounded. To the Appellant’s knowledge, there is no statute, case law, rule or guideline supporting a conclusion that an invention is merely considered a design choice because the specification of the application “provides no unexpected or surprising results” for a particular limitation. Appellant submits that this type of unsupported conclusion – where everything is a conclusory “design choice” if no unexpected or surprising

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results are reported in the specification – is specifically discouraged by the most recent presiding case law, which provides “rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Intern. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Accordingly, Appellant submits that the examiner has not met his burden of supporting a prima facie conclusion of obviousness with respect to claim 55, as required under M.P.E.P § 2142.

VIII. Claims Appendix

1. – 40. (Cancelled)

41. A handle for a lacrosse head comprising:

a hollow tube having an interior surface and an exterior surface and extending a length along a longitudinal axis between a first end and a second end;

wherein one of said first and second ends is adapted for attachment to a lacrosse head;

wherein said hollow tube has a wall thickness defined in a plane normal to said longitudinal axis between said interior surface and said exterior surface;

wherein said hollow tube is polygonal in cross-section in said plane wherein said wall thickness varies about said longitudinal axis in said plane;

wherein said hollow tube includes a first range about said longitudinal axis of relatively thicker wall thickness and a second range about said longitudinal axis of relatively thinner wall thickness such that said first range has a greater weight than said second range, said first range and said second range operably associated with one another;

wherein a difference in weight between said first range and said second range provides said hollow tube with an asymmetric weight distribution about said longitudinal axis that provides tactile feedback to a user of said hollow tube as to the orientation of said hollow tube, and thus the lacrosse head, in the user's hand;

wherein said wall thickness is substantially constant about said first range and wherein said first range extends about 120 degrees around said longitudinal axis.

42. The handle of claim 41 wherein said wall thickness is substantially constant about said second range and wherein said second range extends at least 180 degrees around said longitudinal axis.

43. (Cancelled)

44. The handle of claim 41 wherein said wall thickness includes a third range about said longitudinal axis of transition between said relatively thicker wall thickness and said relatively thinner wall thickness and wherein said third range extends between about 9 degrees to about 17 degrees around said longitudinal axis and wherein said wall thicknesses of said first and second ranges are constant.

45. The handle of claim 44 wherein said wall thickness is substantially constant about said first and second ranges.

46. The handle of claim 41 wherein said hollow tube includes an outer perimeter that is substantially uniform along the longitudinal length of said hollow tube.

47. The handle of claim 41 wherein said second range extends about said longitudinal axis a greater angle than said first range.

48. – 49. (Cancelled)

50. The handle of claim 41 wherein said polygonal cross-section of said hollow tube includes a plurality of sides and wherein over half of the sides of said polygonal cross-section are in said second range, having said relatively thinner wall thickness.

51. The handle of claim 41 wherein said sides of said polygonal cross section of said hollow tube in said second range are disposed adjacent to one another about said longitudinal axis.

52. The handle of claim 41 wherein said first range of relatively thicker wall thickness is disposed on only one side of said longitudinal axis in a plane normal to said longitudinal axis.

53. (Cancelled)

54. A handle for a lacrosse head comprising:

a hollow tube having a longitudinal length extending along a longitudinal axis between a first end and a second end, said first end adapted to connect to a lacrosse head, said hollow tube including an interior surface and an exterior surface defining a wall thickness therebetween, said exterior surface having an octagonal shape in cross section along a plane normal to said longitudinal axis, said octagonal shape including eight sides and eight corners, wherein the hollow tube includes an outer perimeter that is substantially uniform from the first end to the second end, wherein said hollow tube defines a centerline extending in said plane through said longitudinal axis, the center line dividing the hollow tube into opposing first and second portions wherein the wall thickness of at least one of said sides and said corners in the first portion is greater than the wall thickness of at least one of said sides and said corners in the second portion, such that the difference in wall thickness provides said hollow tube with an asymmetrical weight distribution about said centerline that provides feedback to the user of the lacrosse stick as to the orientation of the hollow tube, and thus the lacrosse head, in the user's hands.

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55. The lacrosse handle of claim 54 wherein all of said sides and said corners on said first side of said centerline have a uniform wall thickness that is greater than the wall thickness of all of said sides and said corners on said second side of said centerline.

56. The lacrosse handle of claim 54 wherein at least one of the corners is rounded.

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IX. Evidence Appendix

No evidence has been submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title,
and no other evidence has been entered by the examiner.

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X. Related Proceedings Appendix

No related proceedings.

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In summary, the Examiners' rejections under 35 U.S.C. 103 are improper and/or unfounded, and should be reversed.

Respectfully submitted,

WARRIOR SPORTS, INC.

By: Warner Norcross & Judd LLP

/Chad E. Kleinheksel/

Chad E. Kleinheksel

Registration No. 53 141

900 Fifth Third Center

111 Lyon Street, N.W.

Grand Rapids, MI 49503-2489

(616) 752-2313